

REMARKS

Introduction

Receipt is acknowledged of a non-final office action dated December 31, 2003. In the action, the examiner rejected claims 1, 2, 4-8, 10-12, 14, 19, 23, 33, 63 and 64 allegedly for failing to meet the written description requirement, claims 1, 2, 4-8, 10-12, 14, 19, 23, 33, 52 and 62-64 allegedly for non-enablement, claim 50 allegedly for indefiniteness, claims 1, 2, 4-5, 7, 8, 10, 11, 19, 33 and 62-64 as allegedly anticipated by Feil *et al.*, and claims 6, 23 and 52 for obviousness reasons. The examiner also objected to claims 33 and 52 for formality reasons.

Status of the Claims

In this response, applicants amended claims 1, 4, 7, 33, 50, and 52, and cancelled claims 2 and 62-64. Support for amended claims can be found throughout the specification. *See*, for example, originally filed claims 1, 4 and 7 (support for amended claims 1, 4 and 7), originally filed claim 25 and 30 (support for amended claims 33 and 52), and page 19, lines 1-4 and 11-15, page 35, lines 14-16, pages 29 and 30, and the working examples (support for amended claim 1). Claim 50 was amended for formality reasons. Upon entry of this amendment, claims 1, 4-8, 10-12, 14, 19, 23, 33, 50, and 52 will be under examination.

Claim Objections

The examiner objected to claims 33 and 52 for being dependent upon a non-elected claim. Accordingly, applicants have re-written claim 33 in independent form and amended claim 52 so as to incorporate the features of claim 30 and depend on claim 19.

35 U.S.C. 112, first paragraph

Written Description

In the action, the examiner rejected claims 1, 2, 4-8, 10-12, 14, 19, 23, 33, 63 and 64 allegedly for failing to meet the written description requirement. In particular, the examiner asserted that “[t]he description Applicants refer to [in Applicants’ last response] merely defines the functional activity of the natural or synthetic variants of the recombinase[] or nuclear receptor fragment” and that “the specification does not teach what is the common structure these variants must have to possess such function” (office action at 4).

In the interest of expediting prosecution, applicants cancelled claims 2 and 63-64, and amended claims 1 and 7 so as to not recite the terms “natural variants” or “fragments.” Applicants trust that this amendment obviates the examiner’s rejection.

Enablement

Continuing, the examiner rejected claims 1, 2, 4-8, 10-12, 14, 19, 23, 33, 52 and 62-64 for alleged non-enablement, asserting that the specification “does not reasonably provide enablement for any transgenic mouse comprising a cell comprising [the] claimed transgenes” and “does not enable any transgenic mouse without any phenotype” (office action at 4).

In the interest of expediting prosecution, applicants cancelled claims 2 and 62-64, and amended claims 1 and 4 to recite “a Cre recombinase” and amended claim 1 to recite “wherein the recombinase targets and specifically inactivates said DNA sequences of interest in the presence of synthetic ligand.” Applicants trust that these amendments obviate the instant rejection.

35 U.S.C. 112, second paragraph

The examiner also rejected claim 50 allegedly for indefiniteness. Specifically, the examiner stated that there is insufficient antecedent basis for “said RXR” (office action at 9). Applicants amended claim 50 to more clearly recite the present invention.

35 U.S.C. 102

The examiner rejected claims 1, 2, 4-5, 7, 8, 10, 11, 19, 33 and 62-64 under 35 U.S.C. § 102(b) as allegedly anticipated by Feil *et al.*, *PNAS*, 26:1427 (1998). Specifically, the examiner stated that Feil “discloses a transgenic mouse with loxP sites inserted into the endogenous RXR β gene” (office action at 6).

In the interest of expediting prosecution, applicants cancelled claims 2 and 62-64, and amended claim 1 to recite that “one or more gene or intergenic DNA sequences of interest naturally belonging to said genome of said mouse, wherein said DNA sequence(s) of interest are flanked by one or more recognition sites of said recombinase protein, and are located in one or more of the chromosomes of the genome of said cell.” Support for this amendment can be found throughout the present specification, and in particular, on page 19,

lines 1-4 and 11-15, and on pages 29-30 of the specification. Applicants trust that these claim amendments obviate the instant rejection.

35 U.S.C. 103

The examiner rejected claims 23 and 52 as allegedly obvious over Indra *et al.* (*Nucl. Acid Res.* 27:4324-4327 (1999) and Feil, in view of Ross *et al.* (*PNAS*, 87:9590 (1990)) and Tontonozy *et al.* (*PNAS*, 94:237 (1997)). The examiner also rejected claim 6 as allegedly unpatentable over Feil, in view of Schwenk *et al.* (*Nucleic Acids Res.*, 26:1427 (1998)). Applicants believe that the amendment to claim 1 of the instant invention addresses the examiner's concerns.

CONCLUSION

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and arguments.

It is respectfully urged that the present application is now in condition for allowance. Early notice to that effect is earnestly solicited.

The examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date March 31, 2004

By



FOLEY & LARDNER LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

Stephen B. Maebius
Attorney for Applicant
Registration No. 35,264